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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,877	09/29/2006	Michael Flehinghaus	FLEHINGHAUS ET AL-1 PCT	8126
25889	7590	12/24/2008	EXAMINER	
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			SAWHNEY, HARGOBIND S	
			ART UNIT	PAPER NUMBER
			2885	
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			12/24/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/594,877	<b>Applicant(s)</b> FLEHINGHAUS ET AL.	
	<b>Examiner</b> HARGOBIND S. SAWHNEY	<b>Art Unit</b> 2885	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,3 and 5-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,3 and 5-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The Request for Continued Examination (RCE) and the preliminary amendment, each filed on October 27, 2008 has been entered. According to the preliminary amendment:

- Claims 2, 3 and 5-13 have been amended; Claims 1 and 4 has been canceled; and a new claim 14 has been added.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2, 3 and 5-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 2,693,656 (E. A. Neugass) in view of US Patent No. 4,466,697 (Daniel) .

Regarding claim 1, E. A. Neugass discloses a rear illuminable information unit 17 (Figures 1, 3 and 4) comprising:

- a transparent plastic housing 21 including a front surface- the surface bearing element 19- and a rear surface illuminable by light surface (Figures 1, 3 and 4; column 3, lines 37-42); and a plurality of white pigment particles – light reflective particles - embedded in the transparent

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housing (Figures 1, 3 and 4; column 3, lines 76-85; and column 4, lines 1-8).

As discussed above, E. A. Neugass teaches white pigment particles – reflective particles- being embedded within the transparent plastic housing instead of the embedded particles being transparent – refractive particles- as claimed by the applicant.

On the other hand, Daniel discloses a light dispersive. Light emitting light pipe 20 including transparent body 22 including embedded, transparent particles 40 (Figure 2, column 3, lines 40-50).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the illuminated information unit of E. A. Neugass by providing transparent housing including transparent embedded particle for the benefits of enhanced and uniform light emission.

Regarding claims 1 and 13, E. A. Neugass in view of Daniel discloses the illuminated information unit further including:

- an opaque cover layer 19 disposed on the front surface of the housing 21 (E. A. Neugass, Figures 1, 3 and 4, column 3, lines 33-37); the opaque cover 19 including a plurality of recesses 20 (E. A. Neugass, Figures 1, 3 and 4, column 3, lines 33-37); the recesses in the opaque cover arrangeable for a warning sign exhibition (Instant application, Claim 13).

Regarding claim 1, the limitation “recesses produced by way of laser processing” has no been given patentable weight, as it is a [Product-by-Process limitation], the applicant is advised that patentability of a product does not depend on its method of

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production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966.

Regarding claim 2, neither in combination or individually E. A. Neugass and Daniel specifically teaches the housing or the embedded particles transparently colored.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the illuminated information unit of E. A. Neugass in view of Daniel by providing transparently colored embedded particles or transparently colored body, since it has been held that matters relating to ornamentation only which has no mechanical function cannot be relied upon to patentably distinguish the claimed invention over prior art.

Regarding claim 3, neither in combination nor individually E. A. Neugass and Daniel specifically teaches the transparent housing including a high-temperature-resistant polycarbonate material.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the illuminated information unit of E. A. Neugass in view of Daniel by providing the housing made of a high temperature-resistant polycarbonate material, since it has been held by the courts that selection of a prior art material on the basis of its suitability for its intended purpose is within the level of ordinary skill. *In re Leshing*, 125 USPQ 416 (CCPA 1960) and *Sinclair & Carroll Co. v. Interchemical Corp.*, 65 USPQ 297 (1945).

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Regarding claim 5, E. A. Neugass in view of Daniel discloses the illuminated information unit including the opaque cover layer 19 including recesses 20 (E. A. Neugass, Figures 1, 3 and 4, column 3, lines 33-37); the recesses 20 allowing parts of the housing 21 provided with the covered layer 19 (E. A. Neugass, Figures 1, 3 and 4, column 3, lines 33-37).

Regarding claim 6, neither in combination or individually E. A. Neugass and Daniel specifically teaches the cover layer having a bright color.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the illuminated information unit of E. A. Neugass in view of Daniel by providing the covered layer covered with a bright color, since it has been held that matters relating to ornamentation only which has no mechanical function cannot be relied upon to patentably distinguish the claimed invention over prior art.

Regarding claim 7, E. A. Neugass in view of Daniel discloses the illuminated information unit including the cover plate meeting the limitation in the manner as that applied to claim 6 discussed above.

Regarding claim 8, E. A. Neugass in view of Daniel discloses the illuminated information unit including the plastic housing 21 integral- mechanically or chemically held together- with the operating element 17 - broadly interpreted as the illumination information assembly 17 (E. A. Neugass, Figures 1, 3 and 4)

Regarding claims 9-11, each claim contains a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate

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the claimed apparatus from the prior art, E. A. Neugass in view of Daniel, apparatus, as the prior art apparatus teaches all the structural limitations of the claim.

Regarding claim 12, E. A. Neugass in view of Daniel discloses the illuminated information unit including a cover 18 with vertical walls combinely having a three-dimensional surface structure (E. A. Neugass, Figures 1, 3 and 4, column 3, line 33-37).

### ***Response to Amendment***

4. Applicant's arguments filed on October 27, 2008 with respect to the 35 U.S.C. 102(b) rejections of claims 1, 2 and 5-13; and 35 U.S.C. 103(a) rejections of claim 5 have been fully considered but are moot in view of the new ground(s) of rejections necessitated by the amendment.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Detiker (US Patent No.: 3,694,945), Fye et al. (US Patent No.: 5,432,684), Fye (US Patent No.: 5,736,233), Le Du (US Patent No.: 6,179,430 B1), Williams (US Patent No.: 6,454,422 B1); Tholin et al. (US Patent No.: 6,558,013 B2), Schach et al. (US Patent No.: 7,126,564); and Franklin et al. (US Patent No.: 7,218,824)

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S. Sawhney whose telephone number is

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571 272 2380. The examiner can normally be reached on 8:00 AM - 4:30 PM/30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jong-Suk (James) Lee can be reached on 571 272 7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12/19/08

/Hargobind S Sawhney/  
Primary Examiner, Art Unit 2885